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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,447	10/29/2003	Christopher C. Beatty	100204750-1	6005

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EXAMINER

CHUO, TONY SHENG HSIANG

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,447

Applicant(s)

BEATTY ET AL.

Examiner

Tony Chuo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 42-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/29/03, 7/18/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23 and 42-48, drawn to a method of making a thin film, classified in class 427, subclass 126.3.
 - II. Claims 24-41, drawn to a fuel cell, classified in class 429, subclass 30.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the fuel cell cannot be made by a process that only makes a thin metal oxide film.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. David Collins on 9/7/06 a provisional election was made with traverse to prosecute the invention of Group II, claims 24-41. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 1-23 and 42-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 10/29/03 and 7/18/05 were filed on 10/29/03 and 7/18/05. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Drawings

3. The drawing filed on 10/29/03 are accepted by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both a method of using a fuel cell and a method of making an electrode or electrolyte is indefinite.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102/103 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 24-37 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gopalan et al (US 6492051). The Gopalan reference teaches a fuel cell "10" comprising an air electrode "24", an electrolyte "20", a fuel electrode "12", and an interlayer "22" wherein the interlayer comprises a two phase mixture of particles: 1) yttria stabilized zirconia or doped cerium oxide and 2) doped lanthanum manganite and an organic binder such as polyvinyl alcohol wherein the interlayer is disposed on a ceramic substrate that is the air electrode (See column 3 line 65 to column 4 line 55).

Examiner's note: It is noted that the instant claims are being construed as product-by-process claims and that the product itself does not depend on the process of making it. Accordingly, in a product-by-process claim, the patentability of a product does not depend on its method of production. In that, it is further noted that the product in the instant claims is the same as or obvious over the product of the prior art.

Therefore, the claims are anticipated by Gopalan et al. However, if the claims are not anticipated, the claims are obvious as it has been held similar products claimed in product-by-process limitations are obvious (In re Brown 173 USPQ 685 and In re Fessman 180 USPQ 324 (Refer to MPEP 2113: Product-by-Process Claims)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gopalan et al (US 6492051) in view of Borglum et al (US 6139985). The Gopalan reference is applied to claim 24 for reasons stated above. However, the reference does not expressly teach a metal oxide film that has a thickness ranging between about 0.05 μm and about 5.0 μm . The Borglum reference teaches a CeO_2 interface film that has a thickness of 0.001 micrometers to about 5 micrometers (See column 5, lines 57-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gopalan fuel cell to include a metal oxide film that has a thickness ranging between about 0.05 μm and about 5.0 μm in order to prevent intimate contact between the air electrode and the electrolyte so that the fuel cell could exhibit better performance and lifetime characteristics due to a more uniformly distributed current density as well as protection of the interface. In addition, product claims with numerical ranges which overlap prior art were held to have been obvious (*In re Wertheim* 191 USPQ 90 (CCPA 1976)).

10. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gopalan et al (US 6492051) in view of Ishihara et al (US 5175063). The Gopalan reference is applied to claim 24 for reasons stated above. However, the reference does

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not expressly teach an electronic device comprising a load and the fuel cell of claim 24 connected to the load. The Ishihara reference teaches a fuel cell generator comprising a SOFC element array "11" connected to a load "40" (See Figure 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gopalan fuel cell to include a load connected to the fuel cell in order to efficiently utilize the power generated by the fuel cell.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony Chuo whose telephone number is (571) 272-0717. The examiner can normally be reached on M-F, 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a


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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC



RAYMOND ALEJANDRO
PRIMARY EXAMINER